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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,338	11/27/2001	Jeffry J. Grainger	020313-000730US	1985

20350 7590 01/03/2003

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EXAMINER	
MOONEYHAM, JANICE A	
ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/996,338

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

JANICE A. MOONEYHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on November 27, 2001 and May 29, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- It does not identify the mailing or post office address of the inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
- It does not identify the city and either state or foreign country of residence of the inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.
- It was not executed in accordance with either 37 CFR 1.66 or 1.68. The applicant did not provide the date of execution of the declaration.

### ***Drawings***

The corrected or substitute drawings were received on May 29, 2002. These drawings are unacceptable for the following reasons.

- Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 110(x), 120(y), 120(x), 110(y), system 500, system 200. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Case Data Unit must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

- The applicant has made errors in describing the drawings in the specification. For instance, the applicant refers to Fig. 1 in many instances in which the reference is clearly to Fig. 2. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Appropriate correction is required.
- The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to

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delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

- The applicant makes reference to a pending application and leaves a blank by the application instead of inserting an application number. The applicant should insert the application number of the application in which the applicant is making a reference.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claim 7 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant identifies a Case Data Unit. It is unclear to the examiner what a Case Data Unit is. Is this a name that the applicant is giving its database?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7, 9, 14, 15, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- As for Claims 4-7 and 9:

The applicant states in Claim 4 that the applicant is claiming the method in Claim 1 wherein said first and second communication systems are the public Internet. However, in Claim 1, applicant refers to a first communication network and a second communication network, but never to a communications system. Claims 5 -7 and 9 read on Claim 4.

- As for Claims 14, 15, 17, and 18:

The phrase "include" renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 5, and 8 rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (US Patent No. 6,434,580).

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As for Claim 1:

Takano et al. discloses a method and system of drafting and preparing patent specifications in which there is a client system (100) coupled to a server(300) in which an inventor can enter a piece of draft data for a specification to be included in his or her patent application, a database accessible to the server (303) for storage, a second client computer (200) connected to the server (300) which is used by a patent-application-filing person including a patent attorney revising the draft data with a draft amending means (202); the system having a means for receiving instruction from the inventor (col. 2, line 27), and a means for filing the application with the patent office (1000) (Figs. 1 and 15).

As for Claim 2:

Takano et al. discloses a method and system in which the application can be filed electronically (205, Fig. 15).

As for Claim 4:

Takano et al. discloses a method and system in which the communications network is the Internet (Col. 5, lines 50-51).

As for Claim 5:

Takano et al discloses a method and system in which a patent application is filed with a correspondence mailing address that is an e-mail address (16, Fig. 3).

As for Claim 8:

Takano et al. discloses a method and system in which there is a ready template data which make up a specification form for a patent application enabling the inventor to easily prepare a specification for the patent invention (Col. 9, lines 46-51, Fig. 7).

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Claims 10, 11, 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Eastman Chemical Company (WO 01/08031).

As for Claims 10, 11, 14-16:

Eastman discloses a method and system for managing intellectual property documents and automated processing comprising storing a plurality of electronic documents associated with patent applications assigned to a first and second technology developer in a database accessible to a server system (26, 28) (Fig. 3); assigning access rights, storing assigned rights in a database and enforcing the assigned access rights (page 4, lines 22-23, page 9, lines 9-12, page 10, line 16, page 11, lines 17-19); allowing the creation of patent applications and storing the applications (Figs. 3, 4); and filing the applications with the patent office, said application being filed electronically (Figs. 5A and 5B).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (US Patent No. 6,434,580),

As for Claim 3:

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. Takano does not disclose a method or system in which the patent application is



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printed on a printer and filed in the patent office by mail. However, this would have been obvious to one having ordinary skill in the art since the filing of patent applications by mail preceded electronic filing.

As for Claim 6 and 7:

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. Takano et al. does disclose a system in which the communications network is the Internet (Col. 5, lines 50-51). Takano et al. does not disclose a system or method in which the paper correspondence is scanned into the system and in which the scanned correspondence is viewable over the Internet. However, it would have been obvious to one of ordinary skill in the art to incorporate scanning into the system and method of Takano et al. because scanning saves time since documents do not have to be entered manually into a system. It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. It would be common sense that the method and system disclosed in Takano would allow for scanned documents to be viewed over the Internet since once the documents are entered into the system they would be able to be viewed as any other document in the system.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. as applied to claim 4 above, and further in view of Eastman Chemical Company (WO 01/08031).

As for Claim 9:

Takano et al. discloses a database for storing patent applications (303) (Fig. 1). Takano does not disclose an access management portion. However, Eastman Chemical

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Company discloses one or more access control systems to a patent database (60) (Fig. 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an access management portion as taught in Eastman into the system and method of Takano since patent prosecution is confidential.

Claims 12, 13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eastman Chemical Company as applied to claim 10 above.

As for Claim 12:

Eastman does not disclose a method or system in which the patent application is printed on a printer and filed in the patent office by mail. However, this would have been obvious to one having ordinary skill in the art since the filing of patent applications by mail preceded electronic filing.

As for Claim 13, 17 and 18:

Eastman does not disclose a system or method in which the paper correspondence from the patent office is scanned into the system. However, it would have been obvious to one of ordinary skill in the art to incorporate scanning into the system and method of Eastman because scanning saves time since documents do not have to be entered manually into a system. It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. It would be common sense that the method and system disclosed in Eastman would allow for scanned documents.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The New York Times, January 26, 1998, Section D; Page 2; *Patents: The process of filing an application is slowly catching up with the technology available.*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANICE A. MOONEYHAM whose telephone number is (703) 305-8554. The examiner can normally be reached on MONDAY THROUGH FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3691 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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December 19, 2002

  
**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
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